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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,069	02/28/2005	Amir Karby	P-8978-US	6615

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EXAMINER	
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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/526,069	KARBY, AMIR	
	Examiner	Art Unit	
	WILSON TSUI	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20080304*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This final action is in response to the amendment filed on: 03/04/08, and IDS filed on: 03/04/08.

2. Claims 1-24 are cancelled. Claims 25-31 are new. Claims 25 and 31 are independent claims.

3. The following rejections are withdrawn, in view of applicant's amendments:

- Claims 1, 8, 15, 22, 23, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell, JR in further view of Khan et al.
- Claims 2-5, 9-12, and 16-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell, JR and Khan et al in further view of Takahashi et al
- Claims 6, 7, 13, 14, 20, and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell, JR and Khan et al in further view of Bourdead'hui et al.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 03/04/08 is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. With regards to claim 31, the claimed "print shop product" appears to be a "computer program per se" without hardware. Since the computer program is not embodied in a computer readable medium, the claim is not statutory. See MPEP 2106 below.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held non statutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and thus statutory.

Additionally, with respect to claim 31, the computer program could be embodied in a transmission type media as indicated in the application's specification "Examples of such media include … transmission type media e.g. digital communications links" (page 4, lines 23-24) which can be interpreted as a form of carrier wave. Thus, because carrier waves, being a form of electromagnetic energy, do not fall into one of the statutory categories of 35 U.S.C. 101, the claim includes non-statutory subject matter. A detailed explanation describing why carrier waves are regarded as non-statutory subject matter under 35 U.S.C. 101 follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." Shell Development Co. v. Watson, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), aff'd, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts

have applied similar definitions. See American Disappearing Bed Co. v. Arnaelsteen, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. Lorillard v. Pons, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in American Fruit Growers when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, The Law of Patents for Useful Inventions 270 (1890)).

A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 25-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al (US Patent: 6157934, issued: Dec. 5, 2000, filed: Oct. 15, 1996), in view of Bengston (US Patent: 6728947 B1, issued: Apr. 27, 2004, filed: June 5, 1998).

With regards to claim 25, Khan et al teaches a method comprising:

Associating a first of a plurality of objects with a first of a plurality of work *steps and/or* work *parameters* (Fig 1: whereas a first plurality of objects with work parameters are in a first local spreadsheet)

Associating a second of said plurality of objects with a second of said work *steps and/or* work *parameters* (Fig 1: whereas a second plurality of objects with work parameters are in a second local spreadsheet)*;*

Accepting from a user a production path for a production process, said path comprising said first of said plurality of objects and said second of said plurality of objects (Abstract, Fig. 1, Fig. 2: whereas a production path is accepted from a user to graphically establish linking and workflow paths.)

Assembling a graph of said production path by linking said first of said plurality of objects and said second of said plurality of objects (Abstract, Fig. 1, Fig. 2: whereas a production path is accepted from a user to graphically establish linking and workflow paths.)

Creating an ordered series of production steps based on said work *steps and/or* work *parameters associated with the objects of said graph* (Fig. 3, column 2, lines 40-47: whereas, a series of production/processing steps are created based upon work steps/parameters from each local client)*; and*

Producing a product using series of production steps (Fig. 3: whereas a result/end is produced using series or production steps)

However, Khan et al does not expressly teach the work steps and work parameters are *printing steps* and *printing parameters*. Furthermore, although Khan et al teaches producing a product, Khan et al does not expressly teach the product produced is a *print shop product*.

Yet, Bengston teaches *printing steps* and *printing parameters* in a production/workflow process (Abstract, Fig. 3: whereas a workflow includes printing steps and parameters), and a *print shop product is produced using a series of production steps* (Fig. 3: whereas a printed product is produced).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Khan et al's work flow system, such that the type of workflow is related to a printing workflow, as similarly taught by Bengston. The combination of Khan et al and Bengston would have allowed Khan et al to have implemented "complex workflows [such that] they can be undertaken quickly and inexpensively" (Bengston, column 2, lines 10-11).

With regards to claim 26, which depends on claim 25, Khan et al teaches *wherein said assembling comprises assembling a tree-like graph, and where said creating comprises linking objects of said plurality of objects until reaching a termination leaf of a branch of said tree* (Fig. 3: whereas a tree like graph is assembled, and a termination leaf is reached).

With regards to claim 27, which depends on claim 25, Khan et al teaches *wherein linking said first of said plurality of objects and said second of said plurality of objects comprises associating the output parameters of said first of said plurality of objects as input parameters of said second of said plurality of objects* (Fig. 3: whereas, first and second objects are linked, such as 'manager approves' and 'payrol' approves and processes').

With regards to claim 28, which depends on claim 25, Khan et al teaches *wherein said plurality of objects is configured to receive user input and display output by means of at least one cell in a spreadsheet interface* (column 2, lines 20-45: whereas user input is received via spreadsheet, and also output is displayed via spreadsheet)

With regards to claim 31, for a print shop product produced by a method similar to the method of claim 25 is rejected under similar rationale.

8. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al (US Patent: 6157934, issued: Dec. 5, 2000, filed: Oct. 15, 1996), in view of Bengston (US Patent: 6728947 B1, issued: Apr. 27, 2004, filed: June 5, 1998), and further in view of Kinkos (www.kinkos.com, published: 2001, pages: K1, K2, K3).

With regards to claim 29, which depends on claim 25, Khan et al and Bengston teach *wherein said printing steps comprises printing*. However, the combination of Khan

et al and Bengston do not expressly teach *laminating, cutting, folding, gluing, CD burning, hole making, integrating finished component products, and packaging*

Yet, Kinkos teaches *laminating, folding, holemaking/binding, integrating/*binding and *packaging*/binding (K1, K2: whereas, laminating, folding, hole making/binding, integrating/printing and packaging/binding are shown as printing steps).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Khan et al and Bengston's printing step/workflow system, to have further included steps of printing that include *laminating, folding, holemaking/binding, integrating/*binding and *packaging*/binding, as taught by Kinkos, The combination would have allowed Khan et al and Bengston to have included a variety of printing options available for a printed product.

However, the combination of Khan et al, Bengston and Kinkos do not expressly teach the steps of *cutting, gluing, and CD burning*. Yet, printing steps of cutting, gluing and CD burning are well known in the art, and the Examiner takes OFFICIAL NOTICE of this.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Khan et al, Bengston, and Kinkos' printing steps, to have also included cutting, gluing, and CD burning as printing steps as known in the printing/publishing art. This combination would have allowed more flexible and tailored printing products.

With regards to claim 30, which depends on claim 25, Khan et al and Bengston teach *wherein said printing parameters*. However, the combination do not teach the printing parameters comprising *net amount, weight, cost, size, print quality, and paper type*

Yet, Kinkos teaches printing parameters include *net amount, cost, size, and paper type* (K3: number of pages, and cost per type of paper and printing options).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Khan et al and Bengston's printing parameters, such that printing parameters include factors such as *net amount, cost, size, and paper type*, as taught by Kinkos. The combination would have allowed Khan et al to have accounted for factors of the printing process, for production/cost estimates.

However, the combination of Khan et al, Bengston, and Kinkos do not expressly teach the printing parameters include *weight, and print quality*. Yet, printing parameters such as *weight and print quality* are well known in the printing/publishing art, and the Examiner takes OFFICIAL NOTICE of this.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified khan et al, Bengston, and Kinko's printing parameters, to have further included *weight, and print quality*, as well known in the printing/publishing art. The combination would have allowed Khan et al to have been able to determine production/cost estimates.

Response to Arguments

9. Applicant's arguments with respect to claim 25-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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June 11, 2008